

II. REMARKS

Examiner is requested to consider the application in view of the foregoing amendment.

On PTO Form 326, the Examiner has noted that claims 1-26, 34-66 are pending, but has rejected claims 1-66. It is respectfully submitted that the Office Action is in error in that claims 27-33 have been cancelled.

At page 2, claims 1-26, 34-66 have been rejected pursuant to 35 U.S.C. Sec. 101 for reasons stated in the Office Action.

In response, the rejection is respectfully traversed. The Office Action does not set out a prima facie case of unpatentable subject matter. The rejection is premised on *Bielski*, and the U.S. Supreme Court has accepted the appeal of this decision, drawing the premise of the PTO's view into doubt. To advance prosecution until the Supreme Court decides *Bielski*, Applicant has amended claims 1, 2, 34, 36, and 65 but reserves the right to amend the claims when the appeal has been decided, as well as to pursue the claims in continuation practice, without prejudice.

The rejections of claims 3 and 64 pursuant to Sec. 101, are respectfully traversed. The Office Action is improper for failing to establish why claim 3 is not drawn to a method using an apparatus, and why claim 64 is not drawn to a method of making an apparatus. If the rejection is to be maintained, pursuant to 35 USC Sec. 132 and Rule 104, Applicant requires this "information".

The rejection of claims 62-64, pursuant to Sec. 101, are respectfully traversed. The use of the word "signal" is not improper. Presumably the Examiner is not contending all digital devices and other electrical inventions are unpatentable, because almost anyone would know that they function by electrical signals, and many devices operate by means including signals. The Examiner appears to have confused any use of the word "signal" with a claim drawn to a

"signal" as a purported statutory class under 35 U.S.C. § 101. Input and output signals in a claim drawn to apparatus should not elicit a rejection under 35 U.S.C. Sec. 101. For guidance please see MPEP 2106, 2173.05(g) and compare *Nuijten v. Dudas*, 500 F.3d 1346, 1357 (Fed. Cir. 2007) and *In re Lowry*, 32 F.3d 1579, 1583-84, 32 USPQ2d 1031, 1035 (Fed. Cir. 1994). No amendments have been provided since the Applicant's use of "signal(s)" is proper. Withdrawal of the rejection is earnestly requested.

As to the rejection, pursuant to Sec. 101, of the multiple dependent claims dependent upon claims that depend from claim 3, the rejection is traversed as improper, and there should be no 101-based estoppel as to these claims because claim 3 complies with Sec. 101. The amendment to claim 3 is merely to tidy up the claim.

At page 3, claims 1-26, 34-66 have been rejected pursuant to 35 U.S.C. Sec. 103. The Examiner contends that the claims are obvious based on Eilbacher in view of Marshall.

In response, the rejection is respectfully traversed at least because the applied art fails to disclose expressly claimed elements or limitations, including the following:

As per claim 1

...automatically routing, with the automatic communication system, the communication to an outbound communication path regardless of whether the caller is identified, to one of a plurality of credit-counseling agencies, wherein the routing is responsive to the number and to whether the caller is identified, and to the creditor's referral criteria.

As per claim 2

...routing, automatically with the computer system, the communication to an outbound communication path to one of a plurality of credit-counseling agencies, regardless of whether the caller is identified, wherein the routing is responsive to the number and to whether a prior communication was received from the caller, and if the caller is identified, responsive to the creditor's referral criteria.

As per claim 3

...routing the communication to an outbound communication path to one

of a plurality of credit-counseling agencies, regardless of whether the caller is successfully identified, and a prior communication to the system by the caller causes the computer program to follow a different program logic path in carrying out the routing, and wherein, if the caller is identified, said routing is responsive to a creditor's referral criteria.

As per claim 34

...connecting, automatically with the computer system, the inbound communication to an outbound communication path to the one of the plurality of the credit-counseling agencies in accordance with the creditor's referral criteria.

As per claim 36

...connecting, automatically under control of the computer, the debtor by telephone on an outbound communication path to the one of the stored telephone numbers corresponding to one of the credit-counseling agencies.

As per claim 62

...a digital computer having a processor... programmed to control the digital computer to receive the input signals and to process the input signals to produce the output signals in... selecting one of the credit-counseling agencies by accessing the creditor criteria, applying the creditor criteria, and accessing one of the stored telephone numbers to automatically connect the debtor to the one of the stored telephone numbers on an outbound communication path.

As per claim 64

...programming the processor to control the digital computer to receive the input signals and to process the input signals to produce the output signals in... selecting one of the credit-counseling agencies by accessing the creditor criteria, applying the creditor criteria, and accessing one of the stored telephone numbers so as to connect the debtor to the one of the stored telephone numbers on an outbound communication path.

As per claim 65

...automatically, under control of the computer, connecting the inbound communication to the one of the plurality of the credit-counseling agencies on an outbound communication path in accordance with the creditor referral criteria; and posting call referral data to an Internet web address.

It is respectfully submitted that the rejection has oversimplified the claims and, in doing so, has not read the claims in view of the specification as is required.

As regards Eilbacher, attention is drawn to Col. 6, lines 42-44. "agent work stations...

remote from the communications center” does not disclose the above-excerpted sections of the independent claims, and Marshall appears to be irrelevant in this regard.

In sum, the proposed combination or modification is improper because:

- (1) the applied art fails to disclose expressly claimed elements or limitations;
- (2) the contended combination of teachings to reach the claimed invention would change the principles of operation of the devices shown in the respective cited art;
- (3) no motivation or suggestion has been shown in the cited art that, as of the date of the instant application, would have prompted one skilled in the art to make the combination or modification to reach the claimed invention; and
- (7) the rejection fails to consider the expressly claimed rejection as a whole.

The rejections are improper for further reason. With further regard to the rejection of both the independent claims and claims dependent thereon, it is respectfully submitted that the rejections are in errors pursuant to 35 U.S.C. Sec. 132 (whereby Applicant is entitled to “the reasons for such requirement ... *together with such information as may be useful in judging the propriety of continuing prosecution...*”) and Rule 104(a)(2) (which requires “...reasons for any... requirement... and such information or references will be given as may be useful in aiding the applicant... to judge the propriety of continuing the prosecution).

In view of Sec. 132 and Rule 104, if a combination or modification is to be contended, the PTO is required to provide not only the reasons, but also *such information as may be useful in judging the propriety of continuing prosecution...*”. Otherwise, the rejection is improper.

As regards the proposed combination or modification, the Examiner makes an assertion in the Office Action, at page 3, that:

“It would have been obvious to incorporate the call center involving credit counseling agencies, creditors and debtors into the invention disclosed by Eilbacher, as an alternative use of directing calls throughout the call center.”

This manner in which the rejection of the claims have been set forth fails to comply with Sec. 132 and with Rule 104, and the rejection is therefore defective.

Examiner has the initial burden of proof in presenting a prima facie case of unpatentability. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443, 144 (Fed. Cir. 1993), however, this burden was not been met. Evidence of a reason to combine and modify the separate and disparate references to reach the claim elements has not been shown; evidence that the combination does not change the operation of each individual reference has not been reasonably shown; evidence that their combination would have been common sense such that each piece would have fit together without modification was not provided; and hindsight is well known to be prohibited in making an obviousness rejection. The only nexus between the references that has been used to produce the 103 rejection is the Applicant's own invention and claims: and this is prohibited. Pursuant to Sec. 132 and Rule 104, the Examiner is required to provide this evidence and the corresponding "information."

More particularly, the Examiner has not provided reasonable evidence, rational, or analysis as to why it would have been obvious to one of ordinary skill level in the art, at the time of the invention, to have knowingly modified the cited art to reach Applicant's claimed invention.

Reciting from MPEP 2142, which in part states "[t]he examiner bears the initial burden of ***factually supporting*** any prima facie conclusion of obviousness. If the examiner does not produce a prima facie case, the Applicant is under no obligation to submit evidence of nonobviousness.....the key to supporting any rejection under 35 U.S.C. Sec. 103 is the ***clear articulation of the reason(s) why the claimed invention would have been obvious.***" *[emphasis added]* The Examiner has not clearly articulated any facts supporting a determination of obviousness based upon the above-quoted assertion that the combination of references would have yielded a predictable result or provide for a logical step in the art.

As is also recognized in MPEP 2142, "[t]he Supreme Court in *KSR International Co. v. Teleflex Inc.*, 127 S Ct. 1727(2007), 82 USPQ2d 1385, 1396 noted that the **analysis supporting** a rejection under 35 U.S.C. Sec. 103 **should be explicit.**" [emphasis added] The Examiner has not provided an explicit analysis with facts supporting the rejection.

The Federal Circuit has made clear that "rejection on obviousness cannot be sustained with mere conclusory statement; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness." In *re Kahn*, 441 F.3d 977,988,78 USPQ2d 1329, 1336 (Fed. Cir. 2006). See also *KSR International, Id.*

Rendering a conclusion of obviousness, based upon an assertion that a combination of references would have yielded predictable results without clearly articulating an explicit analysis factually supporting the determination of obviousness of the claim as a whole is merely conclusory. Without providing rational, supported with some evidence, each piecemeal conclusion is also mere conjecture, apparently guided by Applicant's claims.

Another defect of the Examiner's rejection is that it ignores the fact that the "no change in their respective functions" is also required to make the case of obviousness. Citing from MPEP Sec. 2143:

The rationale to support a conclusion that the claim would have been obvious is that all the claimed elements were known in the prior art and one skilled in the art could have combined the elements as claimed by known methods with **no change in their respective functions**, and the combination yielded nothing more than predictable results to one of ordinary skill in the art. *KSR*, 550 U.S. at ___, 82 USPQ2d at 1395; *Sakraida v. AG Pro, Inc.*, 425 U.S. 273, 282, 189 USPQ 449, 453 (1976); *Anderson's-Black Rock, Inc. v. Pavement Salvage Co.*, 396 U.S. 57, 62-63, 163 USPQ 673, 675 (1969); *Great Atlantic & P. Tea Co. v. Supermarket Equipment Corp.*, 340 U.S. 147, 152, 87 USPQ 303, 306 (1950). "[I]t can be important to identify a reason that would have prompted a person of ordinary skill in the relevant field to combine the elements in the way the claimed new invention does." *KSR*, 550 U.S. at ___, 82 USPQ2d at 1396. **If any of these findings cannot be made, then this rationale cannot be**

used to support a conclusion that the claim would have been obvious to one of ordinary skill in the art. [emphasis added]

Due to the dearth of "information" (Sec. 132 and Rule 104) as to the reasons to combine or modify the cited art, the Examiner has not shown that with the combination of references there would be "no change in their respective functions".

Therefore, pursuant to 35 U.S.C. Sec. 132 and Rule 104, the Examiner is required to provide "information" as to: evidence of a reason to combine and modify the separate and disparate references to reach the claim elements has not been shown; evidence that the combination does not change the operation of each individual reference has not been reasonably shown; evidence that their combination would have been common sense such that each piece would have fit together without modification was not provided. As the Examiner is well aware, hindsight is prohibited in making an obviousness rejection. In view of the enormous leap of faith in the above-quoted assertion, if the contention is maintained, the evidence or the Examiner's affidavit or declaration as the evidence is hereby required.

For yet further error in the Office Action, consider now to the reasoning of the enclosed Board Decision of Ex Parte Eugene Howard Massey Jr.

"...given the disparity of problems addressed by the applied prior art references, and the differing solutions proposed by them, any attempt to combine them in the manner proposed by the Examiner could only come from Appellant's own disclosure...even assuming, arguendo, that proper motivation were established for the Examiner's proposed combination of references, we fail to see how and in what manner the references could be combined to arrive at the specific combination set forth in the appealed independent claims."

Though not binding precedent, the reasoning is apt in view of the foregoing combination of references. If the Sec. 103 rejections are maintained, as per Massey, it is also the Examiner's burden under Sec. 132 and Rule 104 to provide "information" as to why the reasoning of Massey is not applicable in the instant case.

Again, the defects in the rejection of independent claims are equally applicable to the dependent claims and other claims that recycle and compound the defects.

Applicant hereby requests an interview with the Examiner and Supervisor. The application, as amended, is believed to be in condition for allowance, and favorable action is requested.

III. CONCLUSION

The Commissioner is hereby authorized to charge any fees associated with the above-identified patent application or credit any overcharges to Deposit Account No. 50-0235, and if any extension of time is needed to reply to said office action, this shall be deemed a petition therefor.

With respect to the present application, the Applicant hereby rescinds any disclaimer of claim scope made in the parent application or any predecessor or related application. The Examiner is advised that any previous disclaimer, if any, and the prior art that it was made to avoid, may need to be revisited. Nor should a disclaimer, if any, in the present application be read back into any predecessor or related application.

If the prosecution of this case can be in any way advanced by a telephone discussion, the Examiner is requested to call the undersigned at (312) 240-0824.

Respectfully submitted,



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